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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,130	11/05/2001	Patrick Raugel	OSTEONICS 3.0-322	2165
530	7590	01/27/2004	EXAMINER	
LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			DAVIS, DANIEL J	
			ART UNIT	PAPER NUMBER
			3731	9
DATE MAILED: 01/27/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/007,130

Applicant(s)

RAUGEL, PATRICK

Examiner

D. Jacob Davis

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 14-17 and 28-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 18-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7 and 8 6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-27, drawn to an apparatus, classified in class 606, subclass 91.
- II. Claims 28-33, drawn to a method, classified in class 128, subclass 898.

The inventions are distinct, each from the other because of the following reasons:

Inventions Group I and Group II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus may be used in an entirely different process, such as holding a drinking cup.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention:

<u>SPECIES</u>	<u>FIGURES</u>
A	1
B	7

Art Unit: 3731

C	8
D	10
E	12

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 9 and 18 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Art Unit: 3731

During a telephone conversation with Raymond Augustin on January 8, 2003 a provisional election was made without traverse to prosecute the invention of Group I, Specie 1, claims 1-13 and 18-27. Affirmation of this election must be made by applicant in replying to this Office action. Claims 14-17 and 28-33 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 12 recites the limitation "an opening" in line 2. This limitation results in a double inclusion since claim 1, also cites "an opening."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 3731

Claims 1, 3-4, 7-10, 13, 18, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Sasse (DE 299 22 792 U1). Sasse discloses a device for holding a bearing liner (Figs. 1-2) comprising a support 8 having a means for aligning, and an opening, which is the space between elements 8 (as viewed in Fig. 2). The device is a substantially flat plate. Claim 4 is a product-by-process claim. To meet the claim it is required is that the device be capable of being made according to the process. The device can be made from a sheet of material.

The device further comprises a means for retaining/means for securing 9, 11 and 15 comprising a deformable rim, and a retainer 9. The device comprises a manually deformable portion 8.

Regarding claim 18, the retainer (Figs. 1 and 2) comprises a handle portion, which is the outer surfaces of resiliently deformable elements/ a first portion 11. The device further comprises a second portion 9.

Claims 1-4, 6-13, 18, 20-22, 24, 26 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Collito (US 3,316,914). Collito discloses a handling device (Fig. 1 and 3) comprising a support 10 and 28 having a means for alignment, an opening 30, and a deformable rim 28. The intended use of the claim, recited in the preamble, has been fully considered and does not overcome the Collito device. The means for alignment surrounds the opening and is made of a substantially flat plate, which may be made from a sheet of material. The support 10 has a castellated rim. The device comprises a means for retaining, which is the other mating component 28 and 10'. The

Art Unit: 3731

retaining means is "bent" back across the upper rim of where the liner would be positioned. The retainer 28 is made of a collagen, which is manually deformable if sufficient force is applied.

Regarding claim 12, both a lining and its relative dimension to the device are considered functional limitations and are not required to meet the claim. The openings of the support and the retainer are aligned.

The retainer comprises a handle portion 18, a first portion 10 and 28, and second portion 10' and 28. The deformable elements comprise different sections of a first portion 10, the sections are separated by elements 26. The first and second portions are connected by a hinge joint 44 and 46, which forms part of the handle.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 19 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasse '299. It is well known that plastic is lighter in weight and less expensive to manufacture than a metallic material. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device out of plastic to enable the device to be lighter in weight and less expensive to manufacture.

Claims 5, 19, 23 and 25 rejected under 35 U.S.C. 103(a) as being unpatentable over Collito. Collito states that the device is stainless steel. It is well known that plastic is lighter in weight and less expensive to manufacture than a metallic material. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device out of plastic to enable the device to be lighter in weight and less expensive to manufacture.

Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tuke et al. (US 6,451,058).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Jacob Davis whose telephone number is (703) 305-1232. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Milano can be reached on (703) 308-2496. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

DJD
January 12, 2004


MICHAEL J. MILANO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700